Remarks

This Amendment is responsive to the Office Action of August 26, 2005. Reexamination and reconsideration of claims 1-21 is respectfully requested.

Summary of The Office Action

Claim 10 was objected to because of the following informality: (1) the recited "stacked above of the media input unit" in line 12 of claim 10 should be --stacked above the media input unit--. Claim 10 has been amended as suggested by the Examiner.

Claims 1-21 were rejected under 35 U.S.C. § 112, second paragraph, as purportedly being indefinite for failing to particularly point out and distinctly claim the subject matter the applicant regards as the invention. The claims were rejected for antecedent basis problems in independent claims 1, 10, and 16.

Concerning claim 1, the Office Action asserts that the term "the image forming device" in claim 1 has insufficient antecedent basis. The Examiner is directed to the preamble of the claim which reads "an image forming device." Clearly "the image forming device" being referred to is the image forming device called out in the preamble. Thus, claim 1 is not indefinite.

Concerning claim 10, it has been amended to resolve the apparent antecedent basis problem. The second occurrence of "an image forming device" has been amended to read "the image forming device", which resolves the antecedent basis problem. Thus claim 10 is not indefinite. This amendment corrects a typographic error and does not introduce new matter.

Concerning claim 16, it has been amended to change "the image forming device" to "the image forming unit", which has sufficient antecedent basis. Thus claim 16 is not indefinite. This amendment corrects a typographic error and does not introduce new matter.

Claims 1-4, 6-7, 9-14, 16-18 and 20-21 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,348,101, Schonfeld et al. (Schonfeld).

Claims 1,2, and 4-8 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,365,886 Murakami et al. (Murakami).

Claims 1-4 and 16-19 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,918,490 Stemmle (Stemmle).

Claims 15 and 19 were rejected under 35 U.S.C. 103(a) as being unpatentable over Schonfeld when combined with facts of which the Office Action takes "Official Notice".

The Claims Patentably Distinguish Over the References

Independent Claim 1

Claim 1 was rejected under 35 U.S.C. 102(b) as being anticipated by Schonfeld. Claim 1 recites a media handling system that will be used with an image forming device that has two media paths, a primary media path and a duplex media path. The primary media path is the path along which print media is imaged. A duplex (return) media path is generally configured to return imaged print media to the primary media path for double-sided imaging. As described and claimed in the application, the duplex media path can also be configured to accept non-imaged print media as input.

Schonfeld discloses a primary media path (72, 76, 84, 80, 88) that delivers media to where it can be imaged. Schonfeld also discloses a duplex media path (90, 92, 94, 96, 98, 102, 100, 70, 74, 82) by which imaged media can be returned to point 80 in the primary media path. However, Schonfeld does not disclose a media feeder configured to input print media into the duplex media path. While Schonfeld discloses a repository 70 into which imaged media can be returned to the primary media path, repository 70 can not be used to input print media, merely to temporarily store and then return already imaged print media.

For a 102 rejection it is axiomatic that to anticipate a claim, a reference must teach every element of the claim. Section 2133 of the MPEP recites:

> A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

As demonstrated above, Schonfeld does not recite each and every element found in claim 1. For this reason Claim 1 is not anticipated by Schonfeld. Claims 2-9 depend from claim 1 and thus are similarly not anticipated.

Claim 1 was also rejected under 35 U.S.C. 102(b) as being anticipated by Murakami. As described above, claim 1 recites a media handling system that will be used with an image forming device that has two media paths, a primary media path and a duplex media path. As described and claimed in the application, the duplex media path can also be configured to accept non-imaged print media as input.

Murakami discloses a first primary media path (21, 23, 25, 17) that delivers media to where it can be imaged. Murakami also discloses a second primary path (38, 52, 48, 47, 22a, 24) where it joins the first primary path at 25. This second primary path can be used by auxiliary copying device 31. When auxiliary copying device 31 is not present, this second primary path is simply a primary path used by second tray 22. Murakami also discloses a duplex media path (26, 27, 28, 34, 39, 40, 42, 37) by which imaged media can be returned to point 38 in the second primary media path. However, Murakami does not disclose a media feeder configured to input print media into the duplex media path. While Murakami discloses a repository 38 into which imaged media can be stored and then returned to the primary media path, repository 38 can not be used to input print media. For this reason claim 1 is not anticipated.

Claim 1 was also rejected under 35 U.S.C. 102(b) as being anticipated by Stemmle. As described above, claim 1 recites a media handling system that will be used with an image forming device that has two media paths, a primary media path and a duplex media path. As described and claimed in the application, the duplex media path can also be configured to accept non-imaged print media as input.

Stemmle discloses a primary media path (72, 77, 78, 82) that delivers media to where it can be imaged. Stemmle also discloses a duplex media path (82, 92, 67, 86, 67, 94, 90, 102, 76) by which imaged media can be returned to point 77 in the primary media path. However, Stemmle does not disclose a media feeder configured to input print media into the duplex media path. Stemmle only discloses a media feeder configured to input print media into the primary media path. There is no entry point in the duplex media path. Imaged media leaves the imaging region, travels the duplex media path, and is returned to the primary path. For this reason claim 1 is not anticipated.

Claim 2

Claim 2 was rejected under 35 U.S.C. 102(b) as being anticipated by Schonfeld. Claim 2 depends from claim 1. Claim 1 has been shown to not be anticipated and thus claim 2 is similarly not anticipated. Additionally, Claim 2 recites the duplex media path being a substantially horizontal media path. Clearly portions 98, 100, and 82 are not substantially horizontal. For this reason claim 2 is not anticipated by Schonfeld.

Claim 2 was also rejected under 35 U.S.C. 102(b) as being anticipated by Murakami. Claim 2 recites that the duplex media path is a substantially horizontal media path. Whether using the incorrect duplex path provided in the Office Action (from 36 over to near 17) or the actual duplex path, the duplex path is clearly not substantially horizontal. Apparatus 36 is illustrated at approximately 45 degrees off horizontal, and thus is as vertical as it is horizontal.

Claim 2 was also rejected under 35 U.S.C. 102(b) as being anticipated by Stemmle. Claim 2 recites that the duplex media path is a substantially horizontal media path. Over half of the duplex media path in Stemmle is vertical. This is clearly not "substantially horizontal". For this additional reason claim 2 is not anticipated.

Claim 3

Claim 3 was rejected under 35 U.S.C. 102(b) as being anticipated by Schonfeld. Claim 3 depends from claim 1. Claim 1 has been shown to not be anticipated and thus claim 3 is similarly not anticipated. Additionally, claim 3 recites that the media feeder is configured to automatically input non-imaged media into the duplex media path. The apparatus illustrated in Schonfeld can only place imaged media in the duplex media path. There is no apparatus illustrated in Schonfeld for introducing non-imaged media into the duplex media path. Apparatus 103 in Schonfeld likely makes it physically impossible to feed non-imaged media into the duplex path. For this reason claim 3 is not anticipated.

Claim 3 was also rejected under 35 U.S.C. 102(b) as being anticipated by Stemmle. Claim 1 has been shown to not be anticipated and thus claim 3 is similarly not anticipated. Additionally, claim 3 recites that the media feeder is configured to automatically input non-imaged media into the duplex media path. The apparatus illustrated in Stemmle can only place imaged media in the duplex media path. There is no apparatus illustrated in Stemmle for introducing non-imaged media into the duplex media path. For this reason claim 3 is not anticipated.

Claim 4

Claim 4 was rejected under 35 U.S.C. 102(b) as being anticipated by Schonfeld.

Claim 4 was also rejected under 35 U.S.C. 102(b) as being anticipated by Murakami.

Claim 4 depends from claim 1. Claim 1 has been shown to not be anticipated by either Schonfeld or Murakami and thus claim 4 is similarly not anticipated. Additionally, claim 4 recites a high-capacity media storage unit. The apparatus cited by the Office Action, (apparatus 36) is not a high-capacity media storage unit, it is an output tray. A high-capacity media storage unit provides input, it does not accept output. Output tray 36 accepts output and does not provide input.

Claim 4 was also rejected under 35 U.S.C. 102(b) as being anticipated by Stemmle. Once again, claim 4 depends from claim 1 and claim 1 has been shown to be not anticipated by Stemmle and thus claim 4 is similarly not anticipated.

Claim 5

Claim 5 was rejected under 35 U.S.C. 102(b) as being anticipated by Murakami. Claim 5 depends from claim 1. Claim 1 has been shown to not be anticipated by Murakami and thus claim 5 is similarly not anticipated.

Claim 6

Claim 6 was rejected under 35 U.S.C. 102(b) as being anticipated by Schonfeld and as being anticipated by Murakami.

Claim 6 depends from claim 1. Claim 1 has been shown to not be anticipated by either Schonfeld or Murakami and thus claim 6 is similarly not anticipated. Additionally, the apparatus cited by the Office Action as being a media output unit (apparatus 38) is actually the tray into which media that have already been imaged on one side are temporarily stored before being imaged on the other side. For this additional reason claim 6 is not anticipated.

Claim 7

Claim 7 was rejected under 35 U.S.C. 102(b) as being anticipated by Schonfeld and as being anticipated by Murakami.

Claim 7 depends from claim 6 and claim 6 has been shown to not be anticipated by either Schonfeld or Murakami and thus claim 7 is similarly not anticipated. Additionally, the apparatus cited by the Office Action as being a media output unit (apparatus 38) is actually the tray into

which media that have already been imaged on one side are temporarily stored before being imaged on the other side. For this additional reason claim 7 is not anticipated.

Claim 8

Claim 8 was rejected under 35 U.S.C. 102(b) as being anticipated by Murakami. Claim 8 depends from claim 6 and claim 6 has been shown to be not anticipated by Murakami. Thus, claim 8 is similarly not anticipated. Additionally, the apparatus cited by the Office Action as being a media output unit (apparatus 38) is actually the tray into which media that have already been imaged on one side are temporarily stored before being imaged on the other side. For this additional reason claim 8 is not anticipated.

Claim 9

Claim 9 was rejected under 35 U.S.C. 102(b) as being anticipated by Schonfeld. Claim 9 depends from claim 6 that depends from claim 1. Both claim 6 and claim 1 have been shown to not be anticipated and thus claim 9 is similarly not anticipated. Additionally, claim 9 recites a media finishing device. The specification describes a media finishing device performing tasks like collecting, sorting, collating, stapling, hole punching, and the like. Apparatus 104 merely flips over a printed media and apparatus 108 merely holds the printed media. Thus, neither apparatus 104 nor 108 are "a media finishing device" as claimed. For this additional reason, claim 9 is not anticipated.

Independent Claim 10

Claim 10 was rejected under 35 U.S.C. 102(b) as being anticipated by Schonfeld. Schonfeld discloses a primary media path (72, 76, 84, 80, 88) that delivers media to where it can be imaged. Schonfeld also discloses a duplex media path (90, 92, 94, 96, 98, 102, 100, 70, 74, 82) by which imaged media can be returned to point 80 in the primary media path. However, Schonfeld does not disclose a media input unit configured to input non-imaged media into the return media path. While Schonfeld discloses a repository 70 into which imaged media can be returned to the primary media path, repository 70 can not be used to input non-imaged print media, merely to return print media. Apparatus 103 likely makes it physically impossible to input non-imaged media into the return media path of the image forming device. For this reason

claim 10 is not anticipated. Claims 11 – 15 depend from claim 10 and thus are similarly not anticipated.

Claim 11

Claim 11 was rejected under 35 U.S.C. 102(b) as being anticipated by Schonfeld. Claim 11 depends from claim 10. Claim 10 has been shown to not be anticipated and thus claim 11 is similarly not anticipated. Additionally, claim 11 recites the duplex media path being a substantially horizontal media path. Clearly portions 98, 100, and 82 are not substantially horizontal. For this reason claim 11 is not anticipated by Schonfeld.

Claim 12

Claim 12 was rejected under 35 U.S.C. 102(b) as being anticipated by Schonfeld. Claim 12 depends from claim 10. Claim 10 has been shown to not be anticipated and thus claim 12 is similarly not anticipated.

Claim 13

Claim 13 was rejected under 35 U.S.C. 102(b) as being anticipated by Schonfeld. Claim 13 depends from claim 10. Claim 10 has been shown to not be anticipated and thus claim 13 is similarly not anticipated. Additionally, claim 13 recites a media finishing device. The specification describes a media finishing device performing tasks like collecting, sorting, collating, stapling, hole punching, and the like. Apparatus 104 merely flips over a printed media and apparatus 108 merely holds the printed media. Thus, neither apparatus 104 nor 108 are "a media finishing device" as claimed. For this additional reason, claim 13 is not anticipated.

Claim 14

Claim 14 was rejected under 35 U.S.C. 102(b) as being anticipated by Schonfeld. Claim 14 depends from claim 10. Claim 10 has been shown to not be anticipated and thus claim 14 is similarly not anticipated.

Claim 15

Claim 15 was rejected under 35 U.S.C. 103(a) as being unpatentable over Schonfeld when combined with facts of which the Office Action takes "Official Notice". This obviousness rejection suffers from at least two flaws. First, the reference and the "officially noticed" modification still do not describe each and every limitation in the claimed subject matter. Second the Office Action does not ascertain and identify the skill level of one skilled in the art. For these reasons claim 15 is not obvious.

The proposed modification does not describe every limitation of the subject matter claimed in claim 15. To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. MPEP 2143.01 Second, there must be a reasonable expectation of success. MPEP 2143.02 Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Here, the prior art reference and the "officially noticed" facts do not teach or suggest all the claim limitations.

Schonfeld discloses a primary media path (72, 76, 84, 80, 88) that delivers media to where it can be imaged. Schonfeld also discloses a duplex media path (90, 92, 94, 96, 98, 102, 100, 70, 74, 82) by which imaged media can be returned to point 80 in the primary media path. However, Schonfeld does not disclose a media input unit configured to input non-imaged media into the return media path. While Schonfeld discloses a repository 70 into which imaged media can be returned to the primary media path, repository 70 can not be used to input non-imaged print media, merely to return print media. Apparatus 103 likely makes it physically impossible to input non-imaged media into the return media path of the image forming device. For this reason claim 15 is not obvious over Schonfeld and the "officially noticed" modification.

The Office Action also does not ascertain and identify the skill level of the person of ordinary skill in the art who would be motivated to make the modification. The MPEP requires that the Office Action ascertain and describe the level of ordinary skill so that objectivity can be maintained. MPEP 2141.03 reads:

> The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry. *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718, 21 USPQ2d 1053, 1057 (Fed. Cir. 1991). The examiner must ascertain what would have been obvious to one of ordinary skill in

> the art at the time the invention was made, and not to the inventor, a judge, a layman, those skilled in remote arts, or to geniuses in the art at hand. *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 218 USPQ 865 (Fed. Cir. 1983), *cert. denied*, 464 U.S. 1043 (1984).

Here the Office Action neither ascertains nor reports on the level of ordinary skill in the art. For this additional reason all the obviousness rejections are improper.

Independent Claim 16

Claim 16 was rejected under 35 U.S.C. 102(b) as being anticipated by Schonfeld. Schonfeld discloses a primary media path (72, 76, 84, 80, 88) that delivers media to where it can be imaged. Schonfeld also discloses a duplex media path (90, 92, 94, 96, 98, 102, 100, 70, 74, 82) by which imaged media can be returned to point 80 in the primary media path. However, Schonfeld does not disclose the duplex media path being configured to receive non-imaged print media from the media storage unit and to input the non-imaged print media to the primary media path for imaging. While Schonfeld discloses a repository 70 into which imaged media can be returned to the primary media path, repository 70 can not be used to input non-imaged print media, it can merely be used to return print media. Apparatus 103 likely makes it physically impossible to input non-imaged media into the return media path of the image forming device. For this reason claim 16 is not anticipated. Claims 17-21 depend from claim 16 and thus are similarly not anticipated.

Claim 16 was also rejected under 35 U.S.C. 102(b) as being anticipated by Stemmle. As described above, claim 16 recites a media handling system that will be used with an image forming device that has two media paths, a primary media path and a duplex media path. As described and claimed in the application, the duplex media path can also be configured to accept non-imaged print media as input.

Stemmle discloses a primary media path (72, 77, 78, 82) that delivers media to where it can be imaged. Stemmle also discloses a duplex media path (82, 92, 67, 86, 67, 94, 90, 102, 76) by which imaged media can be returned to point 77 in the primary media path. However, Stemmle does not disclose the duplex media path being configured to receive non-imaged print media. Stemmle only discloses a media feeder configured to input print media into the primary media path. There is no entry point in the duplex media path. Imaged media leaves the imaging

region, travels the duplex media path, and is returned to the primary path. For this reason claim 16 is not anticipated.

Claim 17

Claim 17 was rejected under 35 U.S.C. 102(b) as being anticipated by Schonfeld. Claim 17 depends from claim 16. Claim 16 has been shown to not be anticipated and thus claim 17 is similarly not anticipated.

Claim 17 was also rejected under 35 U.S.C. 102(b) as being anticipated by Stemmle. Once again, claim 17 depends from claim 16, which has been shown to be not anticipated by Stemmle and thus claim 17 is similarly not anticipated.

Claim 18

Claim 18 was rejected under 35 U.S.C. 102(b) as being anticipated by Schonfeld. Claim 18 depends from claim 16. Claim 16 has been shown to not be anticipated and thus claim 18 is similarly not anticipated. Additionally, claim 18 recites a media feeder for feeding non-imaged print media from the media storage unit to the duplex media path. Apparatus 103 blocks the only likely location for this device in the apparatus illustrated in Schonfeld. For this additional reason claim 18 is not anticipated.

Claim 18 was also rejected under 35 U.S.C. 102(b) as being anticipated by Stemmle. Once again, claim 18 depends from claim 16, claim 16 has been shown to be not anticipated by Stemmle and thus claim 18 is similarly not anticipated.

Claim 19

Claim 19 was rejected under 35 U.S.C. 102(b) as being anticipated by Stemmle. Claim 19 depends from claim 17. Claim 17 has been shown to not be anticipated and thus claim 19 is similarly not anticipated.

Claim 19 also was rejected under 35 U.S.C. 103(a) as being unpatentable over Schonfeld when combined with facts of which the Office Action takes "Official Notice". As described above, this obviousness rejection suffers from at least two flaws, not describing each and every limitation in the claimed subject matter, and not ascertaining and identifying the skill level of one skilled in the art. For these reasons claim 19 is not obvious.

Claim 20

Claim 20 was rejected under 35 U.S.C. 102(b) as being anticipated by Schonfeld. Claim 20 depends from claim 16. Claim 16 has been shown to not be anticipated and thus claim 20 is similarly not anticipated. Additionally, claim 20 recites a media finishing unit. The specification describes a media finishing unit performing tasks like collecting, sorting, collating, stapling, hole punching, and the like. Apparatus 104 merely flips over a printed media and apparatus 108 merely holds the printed media. Thus, neither apparatus 104 nor 108 are "a media finishing unit" as claimed. For this additional reason, claim 20 is not anticipated.

Claim 21

Claim 21 was rejected under 35 U.S.C. 102(b) as being anticipated by Schonfeld. Claim 21 depends from claim 16. Claim 16 has been shown to not be anticipated and thus claim 21 is similarly not anticipated. Additionally, claim 21 recites a logic to determine whether print media is inputted into the primary media path or the duplex media path. While Schonfeld describes a circuit for a controller 500, and while controller 500 selects whether to pass forward a media in one of the primary path or the return path, it does not determine whether to input print media into the primary media path or the duplex media path. Controller 500 can not even be modified to perform this task because the apparatus described in Schonfeld can not input print media into the return media path. The apparatus in Schonfeld has a return media path, but that path is only available to print media that have already traveled the primary media path. This is not what is claimed. For this additional reason claim 21 is not anticipated.

Conclusion

For the reasons set forth above, claims 1-21 patentably and unobviously distinguish over the references of record and are now in condition for allowance. An early allowance of all claims is earnestly solicited.

Respectfully submitted,

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PETAR KRAGULJAC (Reg. No. 38,520)
(216) 348-5843